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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,340

Applicant(s)

UCHIDA ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 2/7/05 to the application filed on 6/19/01, priority 6/29/00.
2. Claims 1-2, 11-12 are canceled.
3. Claims 18-21 are added.
4. Claims 3-10, 13-21 are pending in the case. Claims 18-21 are independent claims.
5. The rejections of claims 1-2, 11-12 under 35 U.S.C. 103(a) as being unpatentable over Legh-Smith in view of Zhai have been withdrawn in view of the cancellation of claims 1-2, 11-12.
6. The rejections of claims 3-7, 9-10, 13-17 under 35 U.S.C. 103(a) as being unpatentable over Legh-Smith in view of Zhai have been withdrawn in view of the amendment.
7. The rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over Legh-Smith and Zhai as applied to claim 1 above, and further in view of Lai has been withdrawn in view of the amendment.

Priority

8. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 3-10, 13-21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for rejecting an electronic document based on the assigned priority to each document, does not reasonably provide enablement for rejecting documents including an item that does not meet the target value, extracting a score from the criteria table to add the extracted score to the score counter for each of the *documents that are not rejected*, and assigning a priority to each of *the documents that are not rejected*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The specification discloses a document classification system for classifying documents based on the scores of the items, included in the documents, corresponding to criterion stored in a criteria table. The scores of the items are added up and stored in the score counter of each document. A priority is assigned to a document based on the value of the score counter of each document. Then, the classification system determines whether the electronic document is acceptable based on the assigned priority, and if it is determined that the electronic document needs to be rejected, the classification system generates an electronic email for a rejection notice (specification, Summary of the invention, page 2, line 11 to page 3, line 11).

Therefore, it is clear whether or not a document is rejected is **due to the assigned priority**, not due to the fact that the document includes an item that does not meet the target value as recited in independent claim 20 (and corresponding system claim 18).

Accordingly, it appears that “extracting from the criteria table a score ... score counter” and “extracting from the partner table a score ... score counter” and “assigning, in accordance .. , a priority ..” in claim 20 for each of documents that are not rejected is not reasonable.

Additionally, there is *no score included in the partner table* as disclosed in the specification (page 11, lines 7-10) and figure 4C. Therefore, it is unable to extract the score from the partner table as in claims 18 and 20.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 3-7, 9-10, 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legh-Smith et al. (US pat No. 6,178,419 B1, 1/23/01, filed 5/6/98) in view of Zhai (US Pat App Pub No. 2003/0040930 A1, 2/27/03, 6/5/02, priority 11/2/99) and Puram et al. (US Pat No 6,289,340 B1, 9/11/01, filed 8/3/99).

Regarding independent claim 20, Legh-Smith discloses:

- comparing the value of the item with the target value to reject documents including an item that does not meet the target value (col 7, lines 60-67: weighting of the keywords, where the keywords are the items of the documents, to see how relevant the keywords are to its associated categories implies a comparison the keywords with the category, which is considered a target value, to see if the document is relevant to the category to reject the relevancy of the document)
- for each of documents that are not rejected, extracting the criteria score corresponding to the value of the item to add the extracted score to the score counter (col 7, lines 60-67 and col 11, lines 14-32: scoring each item in a document such as title, heading based on the weighting value; col 11, lines 33-36: summing the scores of the items in each document shows that the obtained score for each item is added to the score value of each document)

- wherein the method further comprises the step of assigning, in accordance with a value of the score counter, a priority to each of the documents that are not rejected (col 6, lines 8-37: the cut-off point indicating that if a page, or an electronic document, has score above the cut-off point value, the page is put in the database, implies that the score is the priority assigned to the page)

Legh-Smith does not disclose that the predetermined criteria is stored in a criteria table.

Zhai discloses that the profile scoring mechanism assigns a score to any document with respect to the profile where the score represents the relevance of the document to a user criteria defined by the profile disclosed in a table ([0013], [0018]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Zhai into Legh-Smith since Zhai provides a table for disclosing the user criteria defined by the profile thus motivating to incorporate in Legh-Smith a table for storing the predetermined criteria to easily access the criteria in the table for scoring documents.

Legh-Smith and Zhai do not disclose:

- for each of documents that are not rejected, extracting from the partner table a score evaluated for attributes of a partner from which the document is received, to add the extracted score to the score counter

Puram discloses a table including items for ranking and scoring skills of a candidate where the scores in the table can be used to determine the rate charged by each candidate to market rates to identify the best candidates (figures 11a-b, col 7, line 5 to col 9, line 10).

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Puram into Legh-Smith and Zhai for the following reason. The table of ranking and scoring skills of candidates in Puram provides scores based evaluating the skills of candidates where the scores are used, which implies to be extracted, for determining the rate charged for each candidate. The Puram table, thus, motivates to apply to Legh-Smith and Zhai for a partner table since the skill score is analogous to the attribute scores of the partner, and scores used for determining the rate charge for each candidate is analogous to scores extracted for determining the priority of the document. The combination of Puram into Legh-Smith and Zhai would provide a way for efficiently classifying documents based on the score data organized and evaluated in the data table and the assigned priorities to the documents.

Regarding claim 21, which is dependent on claim 20, Legh-Smith does not disclose:

- the criteria table further stores a target value score that is to be satisfied by the electronic documents
- wherein the method further comprises the steps of:
 - o setting a recommendation flag in electronic documents having the score counter that has a value greater than the target score
 - o extracting the electronic documents in which the recommendation flag is set

Zhai discloses:

- the criteria table further stores a target value score that is to be satisfied by the electronic documents ([0015]: ([0015]: the score threshold which is used for deciding to accept or reject documents, is equivalent to the target value score to be satisfied the electronic documents)
- wherein the method further comprises the steps of:
 - o setting a recommendation flag in electronic documents having the score counter that has a value greater than the target score ([0015], [0022]: delivering accepted documents yielding a *score above the score threshold* implies that a flag for recommending the accepting of the document is set in programming for delivering process)
 - o extracting the electronic documents in which the recommendation flag is set ([0015],[0022]): *delivering the accepted* document to the user shows that said document is extracted from a corpus of documents)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Zhai into Legh-Smith for efficiently providing a requested document to users based on the evaluation of items within documents and a target value deciding the relevancy of the document to a selected criteria.

Regarding claim 13, which is dependent on claim 20, Legh-Smith and Zhai do not disclose explicitly that the criteria table is provided corresponding to the kind of electronic document.

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However, Legh-Smith discloses that the data is stored in the database tables, the categories are stored in the categories tables, and the weighting values are provided to judge the relevance of a document to a category (col 7, lines 26-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Legh-Smith to include a criteria table that corresponds to the kind of electronic document for the following reason. Legh-Smith discloses the database tables for storing data thus motivating to use a database table in Legh-Smith to store the weighting values, which is considered equivalent to criteria, since these values are the standard for judging the relevance of a document to a category.

Regarding claim 14, which is dependent on claim 20, Legh-Smith discloses that the network is the Internet (col 5, line 66 to col 6, line 7: retrieving a WWW page shows that the network is the Internet).

Legh-Smith further discloses:

- providing an input form page in which a user inputs the contents of the electronic document (col 5, line 66 to col 6, line 7: the fact that a WWW page is retrieved shows that the contents of the electronic document is provided in a form page)

Legh-Smith does not disclose:

- activating a transfer of the electronic document in response to a click of a button provided on the input form page

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Legh-Smith to include activating a transfer of the

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electronic document in response to a click of a button provided in the input form page for the following reason. It was well known in the art in Netscape or Internet Explorer that a web page can have buttons such as Submit, Back, or Print to submit an online form, to go back to the previous page or to print the current web page. It is easy to recognize that by clicking on the Print button, the current web page is transferred to the connected printer to print the current web page as requested. The combination of such the buttons in a web page for performing some predefined functions such as printing or submitting data to Legh-Smith would provide an effective way of presenting the interaction between users and the websites in the Internet.

Regarding claim 15, which is dependent on claim 20, Legh-Smith discloses activating an internal process in response to a request provided by a user, the internal process including at least one of inquiry, approval, modification, e-mail generation and printing process (col 8, lines 54-65: by clicking on the Submit button, a user *submit a query* for a search).

Regarding claim 16, which is dependent on claim 15, Legh-Smith does not disclose that the internal process includes a printing process, and wherein, in response to a request for printing the electronic document, layout the contents of the electronic document on paper in accordance with the size of the paper.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Legh-Smith to include a printing process as an

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internal process since it was well known in the art that the Print feature is provided in the Internet Explorer or Netscape for user to request a print where the size of the paper and the layout of the document is selected by a user. The combination of the printing process as in Internet Explorer and Netscape as said to Legh-Smith would provide a convenient tool for user to print an electronic document with a selected layout and a selected size of paper.

Regarding claim 17, which is dependent on claim 15, Legh-Smith discloses that the internal process is performed via interaction between a user and a personal computer (col 8, lines 54-65: clicking on the Submit button by a user to submit a query for a search shows the interaction between a user and a personal computer).

Claims 3-7, 18 are for a system of method claims 13-17, 20 and are rejected under the same rationale.

Regarding claim 9, which is dependent on claim 18, Legh-Smith does not disclose:

- a determination result storage for storing the value of the assigned priority for each of the electronic documents
- wherein the controller is further configured to provide a page in which a user can modify the value of the assigned priority

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- wherein the controller is further configured to update the value of the assigned priority stored in the determination result storage in response to an instruction for modification provided by the user on the page

Zhai discloses:

- a determination result storage for storing the value of the assigned priority for each of the electronic documents (abstract, [0013]: the profile scoring mechanism assigns a score to any document where the score represents the relevance of the document to a user criteria defined by the profile, this implies that the scores assigned to each document are stored, and since the assigned scores are used for ranking the documents, the scores are considered the assigned priority for each electronic document)
- wherein the controller is further configured to provide a page in which a user can modify the value of the assigned priority ([0013]: the fact that the profile score threshold can be updated shows that the value of the assigned priority, which is the score threshold is modified)
- wherein the controller is further configured to update the value of the assigned priority stored in the determination result storage in response to an instruction for modification provided by the user on the page ([0013], [0023], [0025]: updating the value of the assigned score according to the profile, which is equivalent to the result storage)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Zhai into Legh-Smith since Zhai discloses

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storing the assigned scores, using these scores for ranking documents, and updating the score values considered as priorities of documents thus motivating to incorporate these features in Legh-Smith for providing to users the updated data of the stored priorities assigned to the electronic documents according to the changes of the numbers of documents received at a certain time.

Regarding claim 10, which is dependent on claim 18, Legh-Smith does not disclose a history data storage for storing the progress relating to the electronic document and a page where a user can check on the progress of handling the electronic documents. Zhai discloses a history data storage for storing the progress relating to the electronic document and a page where a user can check on the progress of handling the electronic documents ([0023]-[0026]: the documents, the scores, the profile and the threshold are added in the historical training data for the system implies a history data storage that stores data relating to the document during the updating progress where a user can retrieve these data for checking).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Zhai into Legh-Smith since Zhai discloses a history data storage for storing the data of the updating process providing the advantage to incorporate such a history storage into Legh-Smith for conveniently checking the changes of data in many update times as well as easily reconstructing data based on the recorded data.

Claims 18-19 are for a system of method claims 20-21, and are rejected under the same rationale.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Legh-Smith and Zhai as applied to claim 18 above, and further in view of Lai (US Pat App No. 2001/0037290 A1, 11/1/01, filed 2/26/01, priority 5/24/00).

Regarding claim 8, which is dependent on claim 18, Legh-Smith and Zhai disclose determining whether the electronic document is acceptable based on the assigned priority (Legh-Smith: col 11, lines 33-46, col 6, lines 1-19; Zhai: [0021]).

Legh-Smith and Zhai do not disclose generating an electronic email for a rejection notice if it is determined that the electronic document is not acceptable, and to generate an electronic email for an acceptance notice if it is determined that the electronic document is acceptable.

Lai discloses using email for notifying a consumer if the consumer's application is accepted or rejected ([0030]: "... the consumer's application is rejected and the consumer *is notified by email in an email rejection* step 104... The consumer is *notified by email* in a confirmation step 114 if the consumer's application *is accepted*").

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Lai into Legh-Smith and Zhai since Lai teaches using email for notifying a consumer the rejection or the acceptance of his/her application providing the advantage to incorporate using email for a rejection notice or

an acceptance notice since emailing is a fast and convenient tool for noticing people over the network rather than using the traditional mailing that cost stamp and mailing time.

Response to Arguments

15. Applicant's arguments with respect to claims 3-10, 13-17 have been considered but are moot in view of the new ground(s) of rejection.

Applicants state that the new independent claims 18-21 now include new various recitations different from the claimed limitations presented before. Among these recitations are comparing the value of the item with the target value to reject documents including an item that does not meet the target value, extracting from the criteria table a score corresponding to the value of the item to add the extracted score to the score counter, extracting from the partner table a score evaluated for attributes of a partner from which the document is received to add the extracted score to the score counter, and assigning a priority to the document in accordance with the value of the score counter, where the steps of extracting and assigning are *applied to the documents that are not rejected*. Applicants argue that the cited references do not disclose or even suggest the claimed invention (Remarks, pages 11-12).

Examiner respectfully disagrees.

As mentioned in the 112, first paragraph rejection above, whether or not a document is rejected **due to the assigned priority**, not due to the fact that the document includes

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an item that does not meet the target value as recited in new independent claim 20 (and new corresponding system claim 18). Therefore, it is unable that the steps of extracting and assigning are performed on *documents that are not rejected*. This also contradicts to the summary of the invention (specification, page 2, line 11 to page 3, line 11) where the priority assignment is based on the total score summed up from the scores of the items included in a document and the rejection of a document is based on the assigned priority. Additionally, there is *no score included in the partner table* as disclosed in the specification (page 11, lines 7-10) and figure 4C. Therefore, it is unable to extract the score from the partner table as in claims 18 and 20.

The newly cited references, in combination, disclose and suggest the claimed invention.

See the claim rejections.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fox et al. (US Pat No. 5,832,456, 11/3/98).

Shmueli et al. (US Pat No. 6,442,555 B1, 8/27/02 filed 10/26/99)

Breitzman et al. (US Pat No. 6,175,824 B1, 1/16/01, filed 7/14/99).

Sanders (US Pat No. 6,411,936 B1, 6/25/02, filed 2/5/99).

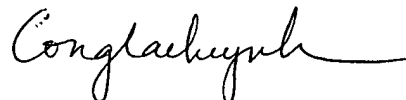
Jacobson et al. (US Pat App No. 2003/0036963 A1, 2/20/03, filed 1/22/01, priority 11/20/00).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
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05/12/05